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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,969	04/04/2001	Thomas D. Doerr	951130.90029	5575
26710	7590	12/14/2005	EXAMINER PORTER, RACHEL L	
QUARLES & BRADY LLP 411 E. WISCONSIN AVENUE SUITE 2040 MILWAUKEE, WI 53202-4497			ART UNIT 3626	

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/825,969

**Applicant(s)**

DOERR ET AL.

**Examiner**

Rachel L. Porter

**Art Unit**

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Notice to Applicant***

1. This communication is in response to the application filed 9/19/05. Claims 1-22 are pending.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

[claim 1]

It is unclear what function being performed in (c) of claim 1. In particular, there does not appear to be any active step performed or recited in step(c). Also it is unclear what is intended by the phrase "whereby entry of a specific diagnosis code may be promoted."

For the purpose of applying art, the Examiner will interpret these limitations to mean that the physician may access information regarding treatment associated with diagnostic codes.

Claims 2-22 include similar language and also inherit the deficiencies of claim 1 through dependency, and are also rejected.

[claim 5]

Claim 5 recites the limitation "the technical references" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. Claims 1 and 4 do not recite technical references.

[claims 10-11]

Claim 10 recites "the selection is a direct selection of a non-diagnosis code item uniquely pre-linked to a diagnosis code to identify the linked diagnosis code." The current claim language is unclear to the Examiner, as seems to contradict the limitations set forth in claim 1, which state "(b) accept from the physician ...a selection identifying a specific diagnosis code from the diagnosis code; (c) only after identification of a specific diagnosis code..." For the purpose of applying art, the Examiner will interpret the language of claim 10 to mean that system will accept information regarding a diagnosis in more than one form (i.e. by description, by symptom, by recommended treatment, code).

Claim 11 inherits the deficiencies of claim 10 through dependency and is therefore also rejected.

#### ***Claim Objections***

4. The objection to claim 17 is hereby withdrawn due to the amendment filed 9/19/05.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4-12 and 14-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Evans (USPN 5,924,074).

[claim 1] Evans discloses a decision support system comprising:

- a hand-held terminal usable during examination and providing a display and physician input device; (see Abstract, col. 2, lines 47-50; col. 5, lines 8-21)
- a terminal server communicating with the hand-held terminal and executing a stored program to:
  - o present on the display of the hand-held terminal a navigation menu presenting diagnosis codes representing different medical diagnoses; (Fig. 20; col. 11, lines 37-50)
  - o accept from the physician input device of the hand-held terminal a selection identifying a specific diagnosis code from the diagnosis codes; and (col. 11, lines 37-50)
  - o access information regarding treatment associated with diagnostic codes. (col. 11, lines 54-60)

It is noted that the Applicant has amended the preamble of each claim to recite "point of care." However, the amendment to the preamble has not altered the Examiner's interpretation of the claims.

[claim 4] Evans teaches a decision support system wherein physician support features include display of physician educational information related to at least one of the diagnosis and treatment. (Figure 18; col. 11, lines 10-30)

[claim 5] Evans teaches a support system wherein the technical references include hyperlinks to physician educational information. (Figure 24; col. 13, lines 20-30)

[claim 6] Evans teaches a decision support system wherein the terminal server further accepts from the physician input device of the hand-held terminal a selection identifying a specific patient, (col. 6, lines 55-63) and wherein the additional physician support features include display of a history of related diagnoses and treatments for the patient. (col. 6, line 62-col. 7, line 40; Figures 7-8)

[claim 7] Evans teaches a support system wherein the display of a history of related diagnoses and treatments for the patient includes identification of at least one medication used in the treatment. (See 112, 2nd paragraph rejection—col. 7, lines 41-52)

[claim 8] Evans teaches a system wherein the diagnosis codes are codes of the international Classification of Diseases developed by the World Health Organization. (Figure 14; col.9, lines 4-7)

[claim 9] Evans teaches a support system wherein the selection is a direct selection of a diagnosis code displayed by the navigation menu. (col. 11, lines 46-50)

[claims 10-11] Evans teaches a support system wherein the selection is a direct selection of a non-diagnosis code item uniquely pre-linked to a diagnosis code (e.g. description of diagnosis) to identify the linked diagnosis code. (Figure 20) Evans further discloses a system wherein the navigation menu displays linked diagnosis codes and treatment options and the selection is a direct selection of a treatment option. (Figure 20; col. 11, lines 27-30) (See 112, 2<sup>nd</sup> paragraph rejection for claims 10-11)

[claim 12] Evans teaches a decision support system wherein the additional physician support features include a listing of treatment options related to the specific diagnosis code. (col. 11, lines 14-22—lists medications that may correspond with a diagnosis)

[claim 14] Evans teaches a decision support system wherein additional physician support features include a listing of procedure options related to the specific drugs. (col. 11, lines 27-30)

[claim 15] Evans teaches a support system, which include access to a searchable database of drugs. (Figures 21-22; col. 12, lines 6-25)

[claim 16] Evans teaches a system wherein the terminal server and the hand-held terminal provide interfaces connecting to the Internet and wherein the terminal server connects with the hand-held terminal via the Internet. (col. 12, lines 56-63; col. 13, lines 13-30)

[claim 17] Evans teaches a support system which provides wireless communication among the devices (i.e. between the hand-held terminal and the terminal server) (col. 2, lines 45-50; col. 13, lines 13-30)

[claim 18] Evans teaches system wherein system wherein the physician input device includes a keyboard or stylus entry device (col. 7, lines 10-14)

[claim 19] Evans teaches a decision support system wherein the display is a graphic display

providing for the display of text and images. (Figure 8; col. 7, lines 11-40)

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans as applied to claim 1 above, and further in view of Denny (USPN 6,687,676) [claims 2-3] Evans discloses a decision support system, as explained in the rejection of claim 1. Evans further discloses that the system provides additional physician support tools (col. 7, lines 41-64), but does not expressly disclose that the system prints patient handouts related to the diagnosis or treatment and printing a prescription for treatment. Denny discloses a system, which prints a prescription for the patient (i.e. a handout related to treatment and a prescription for treatment) (col. 6, line 51-59). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Evans with the teaching of Denny to provide patient handouts related to treatment and printouts of a prescription for treatment. As suggested by Denny, one would have been motivated to include this feature to ensure that the patient given proper dosage and special instructions for treatments (col. 1, lines 42-55) and to facilitate the retrieval and fulfillment of a prescription at a patient-selected pharmacy (col. 7, lines 6-13)



9. Claims 13, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans as applied to claim 1 above, and further in view of Mayaud (USPN 5,845,255)

[claim 13] Evans discloses a decision support system that provides navigation menu lists of diagnosis codes and treatment codes for selection by a user (e.g. physician) (Figure 20, col. 11, lines 37-50), but does not expressly disclose that the diagnosis and treatment codes are listed by the frequency of prior use by a particular physician or group of physicians. Mayaud discloses an adaptive system in which treatments (i.e. prescribed drugs) may be displayed based upon frequency of use (i.e. how often they are ordered by the treating physician(s)). (col. 12, lines 45-54) At the time the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Evans with the teaching of Mayaud to display treatment information based upon the frequency with which it is used by the physician(s). As suggested by Mayaud, one would have been motivated to include this feature to make the system more valuable with increased use, as it adapts to the user's environment and preferences. (col. 12, lines 54-63)

[claims 21-22] Evans discloses a decision support system that provides navigation menu lists of diagnosis codes for selection by a user (e.g. physician) (Figure 20, col. 11, lines 37-50), but does not expressly disclose that the diagnosis codes are listed by the frequency of prior use by a particular physician or group of physicians. Mayaud discloses an adaptive system in which disease conditions may be displayed based upon frequency of use (i.e. how often they are encountered by the treating physician(s)). (col. 12, lines 45-54) At the time the Applicant's

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invention, it would have been obvious to one of ordinary skill in the art to modify the system of Evans with the teaching of Mayaud to display diagnosis information (e.g. codes/conditions) based upon the frequency with which it is encountered by the physician(s) using the system. As suggested by Mayaud, one would have been motivated to include this feature to make the system more valuable with increased use, as it adapts to the user's environment and preferences. (col. 12, lines 54-63)

10. Claims 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Evans as applied to claim 1 above, and further in view of Official Notice.

[claim 20] Evans teaches a decision support system as explained in the rejection of claim 1. Evans further discloses that the display of the system is a graphic display providing for the display of text and images (Figure 8; col. 7, lines 11-40), but does not disclose the resolution of the system display. However, the use of higher resolution displays to view data is well known in the computer arts. At the time of the Applicant's invention it would have been obvious to one of ordinary skill in the art to include the use of a higher resolution display unit (e.g. a display that provides a resolution of at least 600 by 200 pixels) in the system of Evans. One would have been motivated to include this feature to improve the detail displayed in the graphical images (e.g. x-rays), thereby increasing the accuracy of diagnoses made through such images.

***Response to Arguments***

11. Applicant's arguments filed 9/19/05 have been fully considered but they are not persuasive.

(A) It is noted that the Applicant has amended the preamble of each claim to recite "point of care." However, as previously noted, the a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. Moreover, the amendment to the preamble has not altered the Examiner's interpretation of the claims.

(B) Applicant's amendments regarding claim 10 fail to overcome the rejection under 112, 2<sup>nd</sup> paragraph. The limitations of claim 1 recite selection of the diagnosis code itself, and the limitations of claim 10 appear to negate those limitations.

(C) The antecedent basis rejection of claim 5 has been maintained because the phrase, "the technical references," has not been replaced in the claim.

(D) Applicant argues that Evans reference does not teach the conditional access of the reference database as recited in step 1(c) of the Applicant's invention.

In response, the features/language at issue were and are rejected under 35 U.S.C. 112, 2<sup>nd</sup> paragraph as being vague and indefinite. While the applicant may

intend to claim the conditional access of a reference database and practice guidelines, the current claim language does not clearly recite these limitations. The Applicant has not amended the language of claim 1(c). While applicant's explanation on page 6 of the response clarifies certain issues regarding the claim, the Examiner maintains that current language is vague and indefinite. In light the language, the Examiner made an interpretation and applied art accordingly.

If applicant is trying to claim a conditional step as argued, the Examiner suggests "enable physician access to additional support features...only after identification of a specific diagnosis code" or similar language.

Moreover, the current claim language fails to define how the identification of a specific code denies or permits access to the additional features. In other words, the Applicant argues that the physician can gain access to these support features only by selecting an appropriate diagnosis code. Yet, in providing an example of how this feature works in claim 10, the Applicant explains that the physician may select the diagnosis itself (e.g. the description instead of the code) and also gain access.

(E) Applicant argues that the Mayaud and Denny references teach away from and do not remedy the shortcomings of the Evans reference.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### **Conclusion**

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

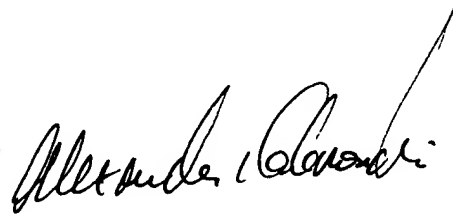
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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SUPERVISORY PATENT EXAMINER